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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/280,609	03/29/1999	DAVID BARCK	6402	6090

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EXAMINER
WILLETT, STEPHAN F

ART UNIT	PAPER NUMBER
2152	9

DATE MAILED: 07/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

		Application No.	Applicant(s)	
Office Action Summary		09/280,609	Barck et al.	
		Examiner	Art Unit	
		Stephan Willett	2152	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____3____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *May 22, 2002* _____ .

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-40* _____ is/are pending in the application.

    4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-40* _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some* c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    *See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

4) ☐ Interview Summary (PTO-413) Paper No(s). _____

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   This application currently names joint inventors. In considering patentability of the claims

under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

commonly owned at the time any inventions covered therein were made absent any evidence to

the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

and invention dates of each claim that was not commonly owned at the time a later invention was

made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35

U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

3.   Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puri with

Patent Number 6,064,982 in view of Christeson et al. with Patent Number 5,926,817.

4.   Regarding claim(s) 1-11, 13, 21-25, 27-33 and 39-40, Puri teaches a product

configuration system over a LAN. Puri teaches *(a) interactively eliciting from a user on the at*

least one client a desired subset of possible products having technical configurations as "the

smart configurator provides interactive, off-line product selection dialog in which a matrix of

company products is presented", col. 3, lines 54-56. Puri teaches *(b) in response to the user's*

desired subset of possible products having technical configurations, downloading from the at

least one server to the at least one client limited configuration information and limited

configuration programs as "various packaged options are available for selection and/or individual

components may be selected", col. 5, lines 52-53, a limited configuration engine or interfaces or

browser pages that merge user entered information, col. 2, lines 30-39, col. 3, lines 24-46 and col.

5, lines 1-15. Puri teaches © *interactively eliciting from the user on the at least one client a*

desired technical configuration and preliminarily checking at the at least one client the viability

of the desired technical configuration using the limited configuration information and the

limited configuration programs as "the smart configurator determines the appropriate hardware

requirements to run the software in an acceptable fashion", col. 3, lines 63-65. Puri teaches *(d)*

uploading the desired technical configuration from the at least one client to the at least one

server and performing a full check on the viability of the desired technical configuration using

full configuration information and full configuration programs on the at least one server as "the

actual hardware requirements for particular software solution are automatically determined by the

smart configurator", col. 5, lines 63-65, "the smart configurator may be optionally placed on-line

to check for the existence of more current pricing and SKU information at a company server,

etc.", col. 4, line 16-21, 28-33 and col. 6, lines 46-52. Puri teaches *(e) responsive to the full*

check, preparing and outputting on the at least one client an electronic order report as "the

smart configurator provides a proposal template that merges various customer related information

into a generic proposal", col. 6, lines 20-22. Puri teaches the invention in the above claim(s)

except for explicitly teaching *desired technical configurations*. In that Puri operates to generate

configuration fields, the artisan would have looked to the network configuration arts for details of

implementing a user selections. In that art, Christeson, a related network configuration system,

teaches an "the same applies to changes to access types and service types", col. 4, lines 9-11 in

order to provide versatility. Christeson specifically teaches that "once the representative has

completed entering all required fields and has selected the appropriate optional fields" at col. 6,

lines 36-37. A user's selection of desired fields is possible and only viable alternatives are

pursued. Further, Christeson suggests that "error messages are displayed with solutions", col. 4,

lines 29 will result from implementing his system. The motivation to incorporate optional fields

insures that only viable configurations are accepted. Thus, it would have been obvious to one of

ordinary skill in the art to incorporate options viability as taught in Christeson into the

configuration system described in Puri because Puri operates with selectable fields and Christeson

suggests that optimization can be obtained with optional fields. Therefore, by the above rational,

the above claims are rejected.

5.   Regarding claims 12, 34 and 36, Christeson teaches *using a TCP/IP connection to pass an*

HTTP request from the client to the server as "such TCP/IP", col. 12, lines 14. Thus, the above

claim limitations are obvious in view of the combination.

6.   Regarding claims 14, 15, 16, 20, 26 and 35-38, Puri teaches *the limited configuration*

programs comprise an HTML page and client-side programs, the client-side programs comprise

a plug-in or helper-application and the client-side programs include one or more programs

selected from Java, JavaScript, ActiveX, and Helper-Viewer and CGIs as "dynamic HTML and

JAVA script", col. 3, lines 13. Thus, the above claim limitations are obvious in view of the

combination.

7.   Regarding claims 17, 18, 19 and, Christeson teaches *the client-side programs are cached*

on the client, the client-side programs are cached in client-side memory and the client-side

programs are cached in client-side disk storage as "removable storage unit, also called a program

storage device or a computer program product, represents a floppy disk, magnetic tape, compact

disk, etc.", col. 14, lines 19-22. Thus, the above claim limitations are obvious in view of the

combination.

Response to Amendment

8.   The broad claim language, i.e. limited configuration engine, used is interpreted on its face

and based on this interpretation the claims have been rejected.

9.   The limited structure claimed, without more functional language, reads on the references

provided. Thus, Applicant's arguments can not be held as persuasive regarding patentability.

10.   Applicant suggests "Puri teaches a system whereby all of the information and all the

functionality is resident on the client side", Paper No. 7, Page 2, lines 19-20. This is correct but

Puri's off-line capability is not mutually exclusive based on the teachings of Puri and what was

reasonable based on the subject matter as a whole as would have been understood at the time the

invention was made to a person having ordinary skill in the art to which the subject matter

pertains. Specifically, Puri teaches "the smart configurator may be optionally placed on-line to

check for the existence of more current pricing and SKU information at a company server, etc.",

col. 4, line 16-21, 28-33 and col. 6, lines 46-52, thus distributed data and applications are taught.

In addition, Christeson clearly teaches obtaining configuration data on-line from various servers,

col. 11, lines 32-44 as was well known. Thus, Applicant's arguments can not be held as

persuasive regarding patentability.

11.   Applicant suggests "it is also undesirable in certain situations to pass the entire application

to the client to allow the client to perform the entirety of the application on the client side", Paper

No. 7, Page 1, lines 10-12, and/or contexts, and "repeated exchanges between the client and

server are avoided", page 2, line 10. The above argument is not commensurate with what is

presently claimed and therefore will not be considered at this time. Puri teaches a limited

configuration engine or interfaces or browser pages that merge user entered information, col. 2,

lines 30-39, col. 3, lines 24-46 and col. 5, lines 1-15. Thus, Applicant's arguments can not be

held as persuasive regarding patentability.

Conclusion

12.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

13.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

14.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Stephan Willett whose telephone number is (703) 308-5230. The examiner

can normally be reached Monday through Friday from 8:00 AM to 6:00 PM.

15.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Mark Rinehart, can be reached on (703) 305-4815. The fax phone number for the

organization where this application or proceeding is assigned is (703) 308-6606.

16.   Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 305-9605.

sfw

July 16, 2002

MARK H. RINEHART
SUPERVISORY PATENT EXAMINER
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